UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,158	01/15/2002	Yosato Hitaka	03500.016099.	8868

5514 7590 10/05/2009

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

EXAMINER	
MENBERU, BENIYAM	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
10/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/045,158	HITAKA, YOSATO	
	Examiner	Art Unit	
	BENIYAM MENBERU	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20,24,25,27 and 29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20,24,25,27 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/1/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed June 5, 2009 have been fully considered but they are not persuasive.

Applicant stated in the Remarks on page 13, that the system of Takeda et al '003 does not disclose a two-step method of selecting a print shop for submitting print orders. However Examiner disagrees because Takeda et al '003 does disclose of a two-step selection method for print shops. In the first step the user can notify a **use condition** consisting of print shop area (column 10, lines 19-22, 26-46; "search condition" set by user can be location information such as "Tokyo";). This results in a first set of print shop candidates (column 10, lines 46-56). The next step consists of the user adding **print conditions** (column 10, lines 1-10) in addition to the use condition previously entered to further narrow down the candidates to generate the second set of candidates (column 10, lines 40-46; emphasis on "stepwise manner" in column 10, lines 42-43; column 11, lines 28-29). After receiving this second set of candidates the user can select one of these printers to submit the print order (column 11, lines 20-28; user selects one printer from the second candidates (list of candidate printers)).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 20, 24, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7441003 to Takeda et al in view of U.S. Patent No. 6822754 to Shiohara further in view of JP 2000-163237 to Migishima.

Regarding claim 20, Takeda et al '003 discloses a user apparatus that communicates with a print management apparatus via a network (Figure 1 shows user apparatus 12 and print manager 16; column 8, lines 62-67; column 9, lines 33-44), comprising:

notifying means for notifying said print management apparatus of a use condition indicating a print shop area, the use condition to be notified being set according to a user operation using an operation page displayed on the user apparatus based on image information generated by said print management apparatus (column 10, lines 19-22, 26-46; "search condition" set by user can be location information such as "Tokyo"; since the web browser can be used for communication between print manager 16 and user apparatus 12, operation page can be displayed on web site for the interaction between the two;);

print shop information obtaining means for obtaining, in advance, print shop information for a plurality of print shops each satisfying the notified use condition, from said print management apparatus as first candidates of print shops to be used for **a respective print order** (column 10, lines 47-57; terminal 12 receives the search result which includes mail address, location, pricing information (print-shop information) about

the printers which is displayed as a list for the first set of candidate printers; column 11, lines 20-41);

extracting means for extracting print shops having a print ability satisfying the print condition, as second candidates to be used for the print order of the single print data from the plurality of print shops included in the print shop information obtained as the first candidates in advance by said print shop information obtaining means (column 10, lines 1-10, 31-44; column 11, lines 28-30; The second candidates of print shops are extracted when additional search conditions are added on top of the initial search condition (use condition above related to print shop area); The initial search condition alone (use condition above) generates the first candidates of print shop satisfying the use condition; When the user adds additional search conditions such as color printing condition, double printing condition, and sheet size condition on top of the initial search condition, a second candidate of print shops will be generated from the first candidate of print shops wherein the second candidate of print shops satisfy the use condition plus the additional print conditions (color printing condition, double printing condition, and sheet size condition).);

selection means for selecting, in accordance with a user operation, one print shop to order print processing, from among the print shops extracted as the second candidates by said extracting means (column 11, lines 20-27; user selects one printer from the second candidates (list of candidate printers));

and print order forming means for forming a print order, including the designation of the selected print shop (column 11, lines 32-55; column 12, lines 9-19;

print order by email with printer designation). However Takeda et al '003 does not disclose print data forming means for forming single print data by using a user interface generated by a printer driver installed in said user apparatus, in accordance with a print condition which is set according to the operation of the user, the user interface not including setting of the print shop area, and the print condition being different from the use condition.

Shiohara '754 discloses print data forming means for forming single print data by using a user interface generated by a printer driver (column 7, lines 34-42, 52-55; driver consists of application program 23 and driver 24) installed in said user apparatus (column 4, lines 21-29), in accordance with a print condition which is set according to the operation of the user (column 11, lines 36-42), the user interface not including setting of the print shop area, and the print condition being different from the use condition (column 9, lines 56-64; temporary print request (print data) does not include area information for print shop).

Having the system of ***Takeda et al '003*** and then given the well-established teaching of ***Shiohara '754***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Takeda et al '003*** as taught by ***Shiohara '754***, since ***Shiohara '754*** stated in col. 2, Lines 11-30, such a modification would provide a faster printing system in a printing network.

However Takeda et al '003 does not disclose plurality of print shops as candidates of print shops to be used for each of respective print orders of a plurality of print data different from each other.

Migishima '237 discloses plurality of print shops as candidates of print shops to be used for each of respective print orders of a plurality of print data different from each other (see Abstract section: plural jobs; paragraph 38, 39, 40, 41; print jobs can be different (color, monochrome, ...)).

Having the system of ***Takeda et al '003*** and then given the well-established teaching of ***Migishima '237***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Takeda et al '003*** as taught by ***Migishima '237***, since ***Migishima '237*** stated in Abstract and paragraph 74, 75, such a modification would provide fast print output system for multiple print jobs/orders.

Regarding claim 24, Takeda et al '003 discloses an information processing system for processing information between a user apparatus and a print management apparatus through communication via a network (Figure 1 shows user apparatus 12 and print manager 16; column 8, lines 62-67; column 9, lines 33-44),

wherein said print management apparatus comprises:

print shop information searching means for searching for information of a plurality of print shops based on a received use condition indicating a print shop area (column 10, lines 1-10, 36-55; searching unit 32 in print manager 16 searches based on use condition corresponding to print shop area position; and

print shop information transmitting means for transmitting the print shop information searched by the print shop information searching means to said user apparatus (column 10, lines 46-57; print manager server 16 transmits printer information to user device 12), and wherein said user apparatus comprises:

notifying means for notifying said print management apparatus of a use condition indicating a print shop area, the use condition to be notified being set according to a user operation using an operation page displayed on the user apparatus based on image information generated by said print management apparatus (column 10, lines 19-22, 26-46; "search condition" set by user can be location information such as "Tokyo"; since the web browser can be used for communication between print manager 16 and user apparatus 12, operation page can be displayed on web site for the interaction between the two;);

print shop information obtaining means for receiving, from the print shop information transmitting means, the print shop information for the plurality of print shops searched by the print shop searching means each satisfying the notified use condition, as first candidates of print shops to be used for **a respective print order** (column 10, lines 47-57; terminal 12 receives the search result which includes mail address, location, pricing information (print-shop information) about the printers which is displayed as a list for the first set of candidate printers; column 11, lines 20-41);

extracting means for extracting print shops having a print ability satisfying the print condition, as second candidates to be used for the print order of the single print data from the plurality of print shops included in the print shop information received as the

first candidates by said print shop information obtaining means (column 10, lines 1-10, 31-44; column 11, lines 28-30; The second candidates of print shops are extracted when additional search conditions are added on top of the initial search condition (use condition above related to print shop area); The initial search condition alone (use condition above) generates the first candidates of print shop satisfying the use condition; When the user adds additional search conditions such as color printing condition, double printing condition, and sheet size condition on top of the initial search condition, a second candidate of print shops will be generated/extracted out of the first candidate of print shops wherein the second candidate of print shops satisfy the use condition plus the additional print conditions (color printing condition, double printing condition, and sheet size condition).);

selection means for selecting, in accordance with a user operation, one print shop to order print processing, from among the print shops extracted as the second candidates by said extracting means (column 11, lines 20-27; user selects one printer from the second candidates (list of candidate printers));
and a print order forming means for forming a print order, including the designation of the selected print shop (column 11, lines 32-55; column 12, lines 9-19; print order by email with printer designation).

However Takeda et al '003 does not disclose print data forming means for forming single print data by using a user interface generated by a printer driver installed in said user apparatus, in accordance with a print condition which is set according to an

operation of the user, the user interface not including setting of the print shop area, and the print condition being different from the use condition.

Shiohara '754 discloses print data forming means for forming single print data by using a user interface generated by a printer driver (column 7, lines 34-42, 52-55; driver consists of application program 23 and driver 24) installed in said user apparatus (column 4, lines 21-29), in accordance with a print condition which is set according to an operation of the user (column 11, lines 36-42), the user interface not including setting of the print shop area, and the print condition being different from the use condition (column 9, lines 56-64; temporary print request (print data) does not include area information for print shop).

Having the system of ***Takeda et al '003*** and then given the well-established teaching of ***Shiohara '754***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Takeda et al '003*** as taught by ***Shiohara '754***, since ***Shiohara '754*** stated in col. 2, Lines 11-30, such a modification would provide a faster printing system in a printing network.

However Takeda et al '003 does not disclose plurality of print shops as candidates of print shops to be used for each of respective print orders of a plurality of print data different from each other.

Migishima '237 discloses plurality of print shops as candidates of print shops to be used for each of respective print orders of a plurality of print data different from each other (see Abstract section: plural jobs; paragraph 38, 39, 40, 41; print jobs can be different (color, monochrome, ...)).

Having the system of ***Takeda et al '003*** and then given the well-established teaching of ***Migishima '237***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Takeda et al '003*** as taught by ***Migishima '237***, since ***Migishima '237*** stated in Abstract and paragraph 74, 75, such a modification would provide fast print output system for multiple print jobs/orders.

Regarding claim 25, see Rejection of claim 20 as shown above. The apparatus of Takeda et al '003 in view of Shiohara '754 further in view of Migishima '237 renders obvious the programming steps of claim 25.

Regarding claim 27, see Rejection of claim 20 as shown above. The apparatus of Takeda et al '003 in view of Shiohara '754 further in view of Migishima '237 renders obvious the method steps of claim 25.

Regarding claim 29, Takeda et al '003 in view of Shiohara '754 further in view of Migishima '237 teaches all the limitations of claim 20. Further Shiohara '754 discloses an apparatus according to claim 20, wherein each of the print condition and the print ability includes at least one of a page size, a media type, a page layout and a finishing option (column 11, lines 58-65; color is a "finishing option").

Other Prior Art Cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6335795 to Neuhard et al disclose printer selection.

U.S. Patent No. 7031929 to Button et al disclose printer system.

U.S. Patent No. 6498656 to Mastie et al disclose printer system.

U.S. Patent No. 5826239 to Du et al disclose method for device selection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENIYAM MENBERU whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner
Beniyam Menberu

/Beniyam Menberu/
Examiner, Art Unit 2625

09/30/2009

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625